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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/705,967

11/13/2003

William Christopher Duffy

US 1362/03

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02/23/2006

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EXAMINER

HEWITT, JAMES M

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/705,967	DUFFY, WILLIAM CHRISTOPHER	
	Examiner	Art Unit	
	James M. Hewitt	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 8 and 12 are objected to because of the following informalities:

In claim 8, line 5, "field modifiable" should be replaced with "able to be modified in the field" for clarity.

In claim 12, line 5, "field modifiable" should be replaced with "able to be modified in the field" for clarity.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (see paragraph [0005] of Applicant's specification) in view of Sullivan (US 4,537,430).

In paragraph [0005], Applicant discloses a fire-rated duct produced by Durasystems Barriers Inc. comprising a support framework (liner section) fabricated from 1/8" steel that is welded into the required type of fitting and then clad with a fire resistant composite panel using specially tested fasteners. This duct assembly differs from the claimed invention only in that the fittings at the ends of the ducts are welded to

the duct assembly instead of using removable fasteners, and in that the joints between the liner section and the fittings (flange assemblies) do not include fire-resistant sealant. Sullivan teaches a duct joining system employing end fittings or flange assemblies that are removably attached to the ducts via removable fasteners (25). In view of Sullivan's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the Durasystem welded fittings with removable fittings in order to permit easier and quicker assembly and disassembly of the ducts during repair or installation and replacement.

As Applicant did not properly challenge the Examiner's taking of official notice of the use of fire-resistant sealant in duct joints, such is considered to be admitted prior art. And in view of such admitted prior art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ fire-resistant sealant at the joints between the liner section and the end flanges in order to enhance fire-resistance of the duct assembly.

Regarding the limitations requiring the assembly components to be pre-assembled at a factory, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, these limitations have not been given patentable weight. Refer to MPEP 2113.

Similarly, regarding the limitations requiring the connector members to be shipped separately from the duct assembly, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, these limitations have not been given patentable weight. Refer to MPEP 2113.

Regarding the recitations requiring the duct sections to form a conduit for running electrical wires, plumbing or for smoke evacuation, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Response to Arguments

Applicant's arguments filed 12/7/05 have been fully considered but they are not persuasive.

Applicant asserts "With reference to the Examiner's characterization of the prior art according to the Applicant, it is noted that the conventional Durasystems fire-rated duct systems as described comprise a support framework which is welded together and then clad with fire resistant composite panels, or a welded inner liner with an insulated cavity and an outer casing. The present invention as defined by independent claims 1, 5, 9 and 13, while directed to embodiments of a fire-rated duct or a duct assembly for a fire-rated conduit, does not comprise either a welded support framework clad with fire resistant panels, nor does it comprise a welded inner liner with an insulated cavity and an outer casing. In view of these differences, it is submitted that even if one skilled in the art were to combine the teachings of Sullivan with the characterization of Applicant's prior art, the resulting apparatus would not be the same as that defined by independent claims 1, 5, 9 and 13. Therefore, on this basis alone it is submitted that the invention as defined by claims 1, 5, 9 and 13 are not obvious." The Examiner disagrees. The

Durasystems duct system "FRD-1" as disclosed by Applicant is a ventilation duct comprising a steel support framework (claimed liner section/inner duct liner) that is welded into a required type of fitting and then clad with a fire-resistant composite panel (claimed non-combustible layer/fire-resistant panel) using fasteners. As described in the above 103(a) rejection, in the FRD-1 system, the fittings are welded rather than removably fastened to the duct framework.

Applicant asserts that Sullivan does not mention or suggest a fire-rated duct of conduit assembly. In response, although he makes no mention of fire-rated duct, Sullivan is applicable to building HVAC systems, particularly duct systems. The HVAC systems of large buildings are required by code to be fire-rated. Note paragraph [0002] of Applicant's specification. Further, the mere fact that Sullivan teaches a duct system, whether fire-rated or not, makes Sullivan relevant and analogous.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Sullivan's teaching of removable fittings provides motivation to replace the welded Durasystem fittings in order to permit easier and quicker assembly and disassembly of the ducts during repair or installation and replacement.

Conclusion

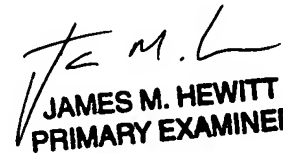
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hewitt whose telephone number is 571-272-7084.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JAMES M. HEWITT
PRIMARY EXAMINER